

REMARKS

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 16-18, 23-40, 42 and 44-60 are pending in the application.

At the outset, the undersigned thanks the Examiner for the courtesies extended during the interview conducted on March 12, 2001.

Applicant notes with appreciation the indication on page 21 of the Office Action that claims 35 and 36 are allowed.

Claims 16 to 18 stand rejected under 35 U.S.C. § 103 as obvious over the West et al patent. Reconsideration and withdrawal of the rejection are respectfully requested.

The Examiner's response on page 22 equates the PIN number to forming a local information label. However, the PIN number does nothing to form the local information label as claimed by the Applicant, but merely provides access to program the system. Therefore, the PIN cannot be equated with forming the local information label.

In contrast, claims 16 to 18 are directed to a feature of the invention which permits a user to generate a local information label based upon the answers to questions which are related to the category labels. The answers to these questions are then used to form the local information labels. Even assuming that West et al system asks a "question" when it requests the users PIN number, the answer to that "question" does nothing to create a local label. Entry of the PIN merely permits the user to be authorized to enter codes which determine the local "censorship content guidelines." There is nothing in the PIN number

entry that is analogous to the category related questions which, when answered, actually create the local label.

Additionally, new dependent claim 58 has been added to recite that the local information label is modified based on program context. The local information label of the Applicant's invention is much more robust than the mere blocking functions presented by West et al. Therefore, West et al. cannot teach the features of the local information label that respond to the context of the program content in which the category related values are occurring. New claims 59 and 60 further emphasize additional novel features of Applicant's invention which are not taught or suggested by West et al.

Accordingly, the rejection to claims 16-18 based on the West et al. is not supported, and withdrawal of the rejection is respectfully requested. New claims 58 to 60 recite further novel features and should be allowable at least for the reasons cited above.

Claims 27 to 33 and 52 to 54 stand rejected under 35 U.S.C. § 103 as being obvious over the patent to West et al. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner's response agrees that the West et al. does not disclose that modifying the values associated with a local information label in response to the user's reaction to the present program. However, the Examiner still maintains that this feature would have been obvious to include in the West et al. system. As stated in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner

appears to have relied on the assumption that West et al. could be modified as the basis for his obviousness reasoning. However, as noted by the Examiner there is no reference or suggestion to make such a modification in West et al. Nothing in West et al suggests the desirability of the creation of a local information label based upon the reaction of the user while actually receiving the information. Therefore, the modification suggested by the Examiner, even if possible, cannot be considered obvious.

Further, claims 27 to 33 and 52 to 54 are directed to the creation of a local information label based upon the reaction of the user while actually receiving the information. It will be appreciated that the received information has an associated information label (the transmitted label) related to information content. In the context of a television program, for example, the transmitted label may specify that the scene contains violence. The user is provided with the ability to create a local label or modify an existing local label while the program is being viewed by inputting the user's reaction to scenes (e.g., acceptable and/or unacceptable). See pages 51 to 53 of the specification.

Nowhere in West, has the Examiner cited to anything even similar to this concept. West discloses creating local "program rating designations" or "censorship content guidelines" by entering rating information via a censorship module 300 (Fig. 3) or on a hand-held control module 47 (Fig. 4). It would appear that the entries are always the ratings themselves and not a viewer reaction (e.g., acceptable/unacceptable) to what is being received.

It would therefore seem that the rejection is based upon the Applicant's own specification, and a rejection made on that basis would rely on improper hindsight. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 23-26 stand rejected under 35 U.S.C. § 103 as being obvious over West in view of Clanton. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner's response argues that Clanton does create a history for users, but does not provide any support for this argument. Still further, the Examiner states that even if the Clanton does not teach this feature that it is not novel, without any support for such an assertion. The Applicant disagrees with the Examiner's rationale and conclusion. The Examiner appears to be looking at the individual elements of the claim and not the claim as a whole. As stated in MPEP § 2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. The creation of a history for a user based upon the information viewed or otherwise used by that particular user in the context of the Applicant's invention allows for a variety of advantageous applications. For instance, in present day system where program menus may have several hundreds of channels simultaneously available, using the viewing history of each user to present a custom menu of acceptable programs of interest to each individual user cannot be considered obvious over the "Top 10" of some third party promoter.

As previously noted, these claims are directed to the creation of a history for a user based upon the information viewed or otherwise used by that particular user. In particular, the incoming information includes an information label which includes at least some aspect of program content. The user has an identification code stored in the apparatus and information related to the label is stored to compile a viewing history for that user.

The Examiner acknowledges that West does not disclose the creation of a viewing history for an individual user. It is respectfully submitted that Clanton does not either. Specifically, the portion of Clanton cited by the Examiner, Col. 7, lines 50-58) discloses a "top 10 listing of video preferences." That does not, however, refer to the top shows watched by a particular viewer (i.e., viewer history), it refers to the top shows watched by most viewers. It is a popularity rating and not a viewer history. When a television station boasts that its show is in the "Top 10", it is not referring to a single viewer. In fact, if a viewer viewed 20 programs, the system could not know which were his or her top 10. Accordingly, Clanton's teaching is not the same as or even similar to Applicant's claimed viewing history. Thus, withdrawal of the rejection of claims 23 to 26 is respectfully requested.

Additionally, claims 49-51, 35 U.S.C. § 103 as obvious over West et. al. alone, recite related subject matter to the above-identified independent claims, and are therefore allowable for reasons similar to those given above. New claim 55 to 57 recite further novel features and should be allowable at least for the reasons cited above.

Claim 34 stands rejected under 35, U.S.C. § 103 as being obvious over the patent to Olivio. Reconsideration and withdrawal of the rejection are respectfully requested.

The Examiner in his response agreed with the Applicant's assertions above, yet used "Official Notice" that "it would have been well known to display an advertisement selected from a group of advertisements to prevent viewing obscene material." However, the Examiner has apparently misread the Applicant's claim as the advertisement is not limited to "prevent the viewing of obscene material" but instead is used "for scheduling an advertisement during a program in relation to content of the program." Claim 34 has been amended to emphasize that the claim is directed to the scheduling of advertisements based on the content of the program. Therefore, the claimed invention allows for advertisements to be scheduled based on the content of the program and not just a particular time, which can enhance the advertisement message and/or avoids embarrassment of the advertiser. See page 56, lines 15 to 28 of the specification and the description at pages 54 and 55 of the specification as it would operate in connection with the Figure 2 embodiment. The Applicant has recognized that advertisers may dictate certain timing of their advertisements based on program content. This aspect of the invention permits that to be done by determining program content from the information labels in the transmitted information and scheduling advertisements based upon those information labels.

The disclosure of Olivio does not teach or even remotely suggest the scheduling of advertisements, let alone doing it based on information content of the information being transmitted. The portion of the Olivio patent relied upon by the Examiner has to do with substituting a less objectionable scene in a program when the viewer has determined that a scene is too explicit or graphic. Olivio states that when a R-rated movie is played, at the onset of an explicit or graphic scene, the video source will be switched to supply "a less

explicit or graphic, e.g., PG-13, substitute scene." Col. 14, lines 30-42. That disclosure has no bearing on the presently claimed scheduling of advertisements by the system operator. Accordingly, reconsideration and withdrawal of the rejection of claim 34 are respectfully requested.

Likewise, claims 45-47, rejected under 35 U.S.C. § 103 as obvious over West et al. based solely on "Official Notice," recite related subject matter to the above-identified independent claim, and are therefore allowable for reasons similar to those given above. New claims also are allowable for the reasons set forth above. Specifically, claim 45 broadly sets forth the method of scheduling advertisements based on the information labels and thus the content of the programs. Claims 46 and 47 set forth additional aspects of this inventive feature wherein the advertisement is scheduled at a certain time after a certain information content as described at pages 54 and 55 of the specification.

Additionally, the Examiner alleges by "Official Notice" that the claimed advertising scheduling features recited in claims 34, and 45-47. The Applicant traverses this rejection because there is no support in the record for the conclusion that the identified features are "old and well known." In accordance with MPEP § 2144.03, the Examiner must cite a reference in support of his position.

Claim 37 stands rejected under 35 U.S.C. § 103 as being obvious over the West et al patent. Reconsideration and withdrawal of the rejection are respectfully requested.

Applicant submits that features recited in independent claim 37 are not disclosed or suggested by the West patent. While West is directed to a viewer discretion system, there is no disclosure of modification of the local information label based upon the transmitted

information label. In West, a user or authority figure can change the manner in which viewing is controlled via the input of exclusion codes. However, Applicant respectfully submits that there is no suggestion, absent improper hindsight reasoning, that a local information label is modified based on the transmittal information label. As such, the West patent fails to disclose or suggest the features of independent claim 37.

Claims 38-40 stand rejected under 35 U.S.C. § 103 as being obvious over the West et al. in view of Olivio.

Claim 38, is not disclosed or suggested by the combination of West and Olivio. West is directed to a viewer discretion television program control system and Olivio describes a media screening device which can remove “offensive” material from a signal in a frame-by-frame manner. In contrast, Applicant’s claim 38 recites blocking a part of the frame which does not compare favorably with the information content label. Additionally, Olivio discloses blocking an entire frame of information based upon information content. West does not disclose or suggest the ability to block part of a frame while permitting another part of the frame to be seen. As such, claim 38 is allowable and dependent claims 39-40 are allowable for at least the foregoing reasons.

Claim 42 stands rejected under 35 U.S.C. § 103 as being obvious over the West et al. in view of Abecassis and in further view of Olivio.

As noted above, claim 38, is not disclosed or suggested by the combination of West and Olivio and the addition of the Abecassis patent does not cure the noted deficiencies with respect to dependent claim 42. The Abecassis patent illustrates a computer based playing system wherein the selective transmission of a variable content program material is

provided as a seamless continuous video program. Within Abecassis, each scene or fragment of a scene is given a variable descriptor. In addition, a view can define personalized video content preferences so that scenes or portions of scenes that the viewer does not want to see, are removed. Abecassis discloses blocking a scene or a part of a scene but does not disclose blocking an objectionable area of a frame. As such, claim 42 is allowable.

Claims 44 and 48 stand rejected under 35 U.S.C. § 103 as being obvious over the West et al patent. Reconsideration and withdrawal of the rejection are respectfully requested.

Regarding claim 44 and 48, the Examiner's response acknowledges that claimed features are not shown in West et al., but still insists that it would have been obvious to include these features. As previously noted, it is not understood why the Examiner would conclude that conventionally available recognition methods would obviously be used in lieu of West's PIN number in his program control system without citing any evidence for that conclusion. The West et al patent itself recognizes that the PIN number may be forgotten and provides an alternative "secondary hidden Master PIN which may be used if the primary one is forgotten." Col. 12, lines 32-34. West even goes to the extreme providing for the recording of pin number by the local television cable operator so that the user can contact the operator if the number is forgotten. Col. 12, lines 36-39. Yet, in spite of the potential to forget a PIN, West does not suggest voice recognition, physical characteristic recognition or the like in lieu of a PIN.

As stated in MPEP § 2141.02, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). The ability to identify a user by a variety of techniques may seem obvious upon the Applicant's presentation of the solution to this problem. However, when West et al. is considered in its entirety, the particular concern with the use of a PIN, as noted above, would tend to show that the modifications suggested by the Examiner are not obvious without a suggestion to use an alternative strategy in face of the recognized deficiencies. Accordingly, reconsideration and withdrawal of the rejection of claims 44 and 48 are respectfully requested.

Additionally, the Examiner alleges by "Official Notice" that the claimed identification means recited in claims 44 and 48. The Applicant traverses this rejection because there is no support in the record for the conclusion that the identified features are "old and well known." In accordance with MPEP § 2144.03, the Examiner must cite a reference in support of his position.

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In view of the foregoing, it is believed that this application is now fully in condition for allowance, and allowance is respectfully requested.

Respectfully submitted,

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Attachment to Amendment dated March 15, 2001

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34. A method for scheduling an advertisement during a program in relation to content of the program, the program having a program information label which rates the instantaneous content of the program at least two levels, the method comprising the steps of:

scanning the program information label to ascertain the instantaneous content level of the program over the duration of the program;

determining one of a plurality of advertisements to be run during said program based upon the instantaneous content level of the program; and

scheduling said one advertisement within the program at a time based on the instantaneous content level of the program information label.